REMARKS

Applicant has amended claims 23, 27, 30, 34-37, 41, 44, 45, 49, and 52, and has cancelled claims 1-22, during prosecution of this patent application. Applicant is not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner rejected claims 23, 37 and 45 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 23, 24, 26, 28, 29, 32, 33, 35-38, 40, 42, 43, 45, 46, 48, 50 and 51 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. WIPO Publication No. 02/063243) in view of O'Carroll (US Patent No. 6,714,794).

The Examiner rejected claims 23, 25, 39 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Bruce et al. (US Patent No. 6,539,080).

The Examiner rejected claims 30, 31, 44 and 52 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by

O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Jones (US Patent No. 6,904,359).

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Kamikawa et al. (JP 9218047).

The Examiner rejected claims 27, 41 and 49 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claims 23, 37, and 45 above, and further in view of Ohler et al. (US Patent No. 6,314,367) and LeFebvre et al. (US Patent No. 5,612,882).

Applicant respectfully traverses the § 112 and § 103 rejections with the following arguments.

35 U.S.C. § 112, Second Paragraph: Claims 23, 37 and 45

The Examiner rejected claims 23, 37 and 45 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner argues: "The terms "first device" and "second device" indicate that these devices are distinct, however claims 24, 38, and 46 indicate that Applicant does not intend these devices to be distinct. These terms are made indefinite by the contradicting claims."

In response, Applicant respectfully contends that the language in claims 23, 37 and 45 is consistent with the "first device" and "second device" being a same device or different devices. There is no language in claims 23, 37 and 45 that requires the "first device" and "second device" to be different devices.

Applicants respectfully request that the Examiner specify language in claims 23, 37 and 45 that allegedly requires the "first device" and "second device" to be different devices.

Based on the preceding arguments, Applicant respectfully maintains that claims 23, 37 and 45 are not unpatentable under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 103(a): Claims 23, 24, 26, 28, 29, 32, 33, 35-38, 40, 42, 43, 45, 46, 48, 50 and 51

The Examiner rejected claims 23, 24, 26, 28, 29, 32, 33, 35-38, 40, 42, 43, 45, 46, 48, 50 and 51 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. WIPO Publication No. 02/063243) in view of O'Carroll (US Patent No. 6,714,794).

Applicant respectfully contends that claims 23, 37, and 45 are not unpatentable over Huckle in view of O'Carroll, because Huckle in view of O'Carroll does not teach or suggest each and every feature of claim 23.

A first example of why claims 23, 37, and 45 are not unpatentable over Huckle in view of O'Carroll is that Huckle in view of O'Carroll does not teach or suggest the feature: "a service centre receiving a signal from a first device, said signal specifying a destination location, a second device, and a request for at least one route leading to the destination location such that the at least one route is to be sent to the second device".

The Examiner argues: "Huckle et al teaches: ... a service centre (the base unit of page 6, lines 1-5) receiving a signal from a first device (user device of page 2, lines 17-22), said signal specifying a destination location (location of page 5, line 10), a second device (user device of page 2, lines 17-22; The signal specifies that the requested information is to be returned to the user device. If this system is run over the internet, as in the drawings and page 2, lines 20-22, the packets will contain a source IP address indicating where the response packets are to be sent.), and a request for at least one route leading to the destination location such that the at least one route is to be sent to the second device (page 5, lines 9-13)".

In response, Applicant acknowledges that the preceding argument by the Examiner is persuasive as to Huckle disclosing the specific limitation of "a service centre receiving a signal from a first device, said signal specifying a destination location ... and a request for at least one route leading to the destination location".

However, Applicant respectfully contends the Huckle does not disclose "said signal specifying ... a second device ... such that the at least one route is to be sent to the second device".

The preceding argument by the Examiner acknowledges the Huckle does not explicitly disclose the preceding specific limitation, but argues that Huckle inherently discloses the preceding specific limitation. In particular, the Examiner argues: "The signal specifies that the requested information is to be returned to the user device. If this system is run over the internet, as in the drawings and page 2, lines 20-22, the packets will contain a source IP address indicating where the response packets are to be sent".

In response, Applicant acknowledges that the packets of the signal received by the service center from the user device over the Internet will contain the source address of the packets, namely the source address of the first device. However, Huckle does not disclose the existence of any data in the signal allegedly indicating that the at least one route is to be sent to the source address in the packet. Therefore, the service center must rely on knowledge external to the signal to know where to send the at least one address. For example, the service center may execute program code that determines where to send routes in response to requests for routes.

Although, Huckle discloses that at least one route is sent to the first device in response to the signal, Huckle does not disclose that the decision by the service center to send the at least one

route to the first device is based on the source address of the packet in the signal. Huckle does not disclose how this decision is arrived at. Perhaps, this decision is arrived at based on the date and/or time at which the signal is received at the service center. Perhaps, this decision is based on other data in the packet (i.e., other than the source address), wherein this other data in the packet is fed into an algorithm at the service center that computes the address to which to send the at least one route. It is entirely speculative as to how this decision is arrived at and it is not legitimate to reject claims 23, 37, and 45 based on speculation.

Therefore, Huckle does not disclose the preceding feature of claims 23, 37, and 45.

A second example of why claims 23, 37, and 45 are not unpatentable over Huckle in view of O'Carroll is that Huckle in view of O'Carroll does not teach or suggest the feature: "determining a device type of the second device during or after said receiving the signal from the first device; and sending at least one set of images to the second device, wherein each set of images of the at least one set of images defines a unique route leading to the destination location, and wherein a total number of the at least one set of images and ***a content*** of each set of the at least one set of images are a function of the determined device type" (emphasis added).

The examiner argues: "Huckle et al fails to specifically teach: "O'Carroll teaches, at column 8, lines 32-37, determining a functionality level of a communication device, and at column 9, lines 26-32, reducing the number of image packets that are sent to a communication device whose functionality cannot handle more images. O'Carroll also teaches at column 3, lines 30-35 that ***the content format*** is varied based on the communication device's requirements." (emphasis added)

In response, Applicant respectfully contends that varying the content format does not constitute varying the content.

O'Carroll, col. 3, lines 46-55 distinguishes between content and content format by reciting: "***The content format specifies how the content is presented or displayed at the communication device***. For example, if the content comprises a graphic content made up of a number of data packets that correspond to graphic images, the graphic content is transmitted with control information that include at least one of number of graphic images, size of each graphic image, graphic display speed, screen size format of each graphic image, and functionality level of the graphic content." (emphasis added)

Therefore, Huckle does not disclose the preceding feature of claims 23, 37, and 45.

In addition, the Examiner has not provided a reason as to why it is allegedly obvious to modify Huckle to incorporate "wherein a total number of the at least one set of images and a content of each set of the at least one set of images are a function of the determined device type". The Examiner has provided a reason for modifying Huckle to include a total number of the at least one set of images being a function of the determined device type. However, the Examiner has not provided a reason for modifying Huckle to include a content of each set of the at least one set of images being a function of the determined device type.

Therefore, the Examiner has not established a *prima facie* case of obviousness in relation to claims 23, 37, and 45.

Based on the preceding arguments, Applicant respectfully maintains that claims 23, 37, and 45 are not unpatentable over Huckle in view of O'Carroll, and that claims 23, 37, and 45 are in condition for allowance. Since claims 24, 26, 28, 29, 32, 33, 35 and 36 depend from claim 23, Applicant contends that claims 24, 26, 28, 29, 32, 33, 35 and 36 are likewise in condition for allowance. Since claims 38, 40, 42 and 43 depend from claim 37, Applicant contends that claims 38, 40, 42 and 43 are likewise in condition for allowance. Since claims 46, 48, 50 and 51 depend from claim 45, Applicant contends that claims 46, 48, 50 and 51 are likewise in condition for allowance.

In addition with respect to claims 36, Huckle in view of O'Carroll does not disclose the feature: "providing relative indicators showing a positional relationship of each image in the at least one set of images relative to another image in the at least one set of images".

The Examiner argues that Huckle, page 6, col. 26 discloses the preceding feature of claim 36.

In response, Applicant asserts that Huckle, page 6, col. 26 discloses that each record in Table 2 contains "One field for each direction (Ahead, Reverse, North, North East etc.)".

In response, Applicant asserts that the preceding text in Huckle, page 6, col. 26 does not disclose a significance or functionality of each direction, and more particularly does not disclose "a positional relationship of each image in the at least one set of images relative to another image in the at least one set of images".

Therefore, claim 36 is not unpatentable over Huckle in view of O'Carroll.

35 U.S.C. § 103(a): Claims 23, 25, 39 and 47

The Examiner rejected claims 23, 25, 39 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Bruce et al. (US Patent No. 6,539,080).

Claim 23

The Examiner incorrectly alleges that claim 23 recites that the first and second devices are different devices, which is incorrect. The language in claim 23 is consistent with the first device and the second device being a same device or different devices. There is no language in claim 23 that requires the first device and the second device to be different devices.

Therefore, rejection of claim 23 under 35 U.S.C. § 103(a) over Huckle as modified by O'Carroll and further in view of Bruce is essentially the same rejection of claim 23 under 35 U.S.C. § 103(a) over Huckle in view of O'Carroll, which has been discussed *supra*.

Claims 25, 39, and 47

Since claims 25, 35 and 47 respectively depend from claims 23, 37, and 45 which Applicant has argued *supra* to not be unpatentable over Huckle as modified by O'Carroll under 35 U.S.C. §103(a), Applicant maintains that claims 25, 35 and 47 are likewise not unpatentable Huckle as modified by O'Carroll, and further in view of Bruce under 35 U.S.C. §103(a).

In addition, claims 25, 35 and 47 do not disclose the feature: "wherein the first and second devices are different devices".

The Examiner argues: "Bruce et al teaches, at the abstract and Figure 3, an operator console (first device) which sends a signal to a system (service centre) requesting a route to a destination be sent to an audio box (second device) so that users may receive navigation assistance without an internet connection (column 1, lines 28-30)... In view of Bruce et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the method for providing navigational instructions as taught by Huckle et al as modified by O'Carroll, **(re claims 23, 25, 39, and** 47) the first and second devices are different devices; since Bruce et al teaches that such a system may provide access to navigation instructions with limited connectivity and minimal phone functionality."

In response, Applicant respectfully contends that the preceding argument by the Examiner for modifying Huckle to include the limitation of the first and second devices being different devices is not persuasive.

First, the navigation instructions provided to the existing device in Huckle are already provided with limited connectivity and minimal phone functionality. The Examiner has not demonstrated how implementing the first and second devices being different devices would further reduce connectivity and phone functionality in Huckle.

Second, implementing the first and second devices being different devices is contrary to the preferred embodiment in Huckle. In particular, Huckle, page 3, lines 1-5 recites: "In the preferred embodiment, the user is provided with the ability to travel `virtually' to a location by navigating through a series of digital photographs taken at street-level from the first-person perspective. The information presented in this way directly represents the `user experience' and, unlike reading a street-map, requires no further translation."

Therefore, claims 25, 35 and 47 are not unpatentable over Huckle as modified by O'Carroll, and further in view of Bruce.

35 U.S.C. § 103(a): Claims 30, 31, 44 and 52

The Examiner rejected claims 30, 31, 44 and 52 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Jones (US Patent No. 6,904,359).

Claims 30, 31, 44 and 52

Since claims 30, 31, 44 and 52 respectively depend from claims 23, 23, 37, and 45 which Applicant has argued *supra* to not be unpatentable over Huckle as modified by O'Carroll under 35 U.S.C. §103(a), Applicant maintains that claims 30, 31, 44 and 52 are likewise not unpatentable Huckle as modified by O'Carroll, and further in view of Jones under 35 U.S.C. §103(a).

In addition, claims 30, 31, 44 and 52 do not disclose the feature: "wherein each set of images comprises a furthest image that is furthest from the destination location, and wherein the furthest images of the plurality of sets of images collectively form on a ring of images surrounding the destination location".

The Examiner argues: "Jones teaches, at Figure 28, illustrating locations surrounding a destination on a circle to indicate that these locations are all the same distance or time away from the destination... In view of Jones' teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the method for providing navigational instructions as taught by Huckle et al as modified by O'Carroll, **(re claims 30, 44, and 52)** wherein the furthest images of the plurality of sets of images collectively form on a ring of

images surrounding the destination location; **(re claim 31)** wherein the ring of images is shaped as a circle whose center is at the destination location; since Jones teaches illustrating locations surrounding a destination on a circle to indicate to a user that the locations are all the same time or distance from a destination, thus giving the user a better sense of where the destination and the surrounding locations are in relation to each other."

In response, Applicant asserts that Jones, FIG. 28 does not depict or otherwise relate to a ring of images surrounding a destination location. The description of Jones, FIG. 28 in Jones, col. 20 lines 50-52 ("When the vehicle crosses any locations matching notification time/s 341, shown in more detail in FIG. 28, the advance warning is activated") seems similarly irrelevant to the preceding feature of 30, 31, 44 and 52.

Applicant respectfully requests that the Examiner explain the alleged relevance of Jones, FIG. 28 to the preceding feature of 30, 31, 44 and 52.

Therefore, claims 30, 31, 44 and 52 are not unpatentable over Huckle as modified by O'Carroll, and further in view of Jones.

35 U.S.C. § 103(a): Claim 34

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claim 23 above, and further in view of Kamikawa et al. (JP 9218047).

Since claim 34 depends from claims 23 which Applicant has argued *supra* to not be unpatentable over Huckle as modified by O'Carroll under 35 U.S.C. §103(a), Applicant maintains that claim is likewise not unpatentable Huckle as modified by O'Carroll, and further in view of Kamikawa under 35 U.S.C. §103(a).

35 U.S.C. § 103(a): Claims 27, 41 and 49

The Examiner rejected claims 27, 41 and 49 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huckle et al. (WIPO Publication No. 02/063243) as modified by O'Carroll (US Patent No. 6,714,794) as applied to claims 23, 37, and 45 above, and further in view of Ohler et al. (US Patent No. 6,314,367) and LeFebvre et al. (US Patent No. 5,612,882).

Since claims 27, 41 and 49 respectively depend from claims 23, 37, and 45 which Applicant has argued *supra* to not be unpatentable over Huckle as modified by O'Carroll under 35 U.S.C. §103(a), Applicant maintains that claims 27, 41 and 49 are likewise not unpatentable Huckle as modified by O'Carroll, and further in view of Ohler and LeFebvre under 35 U.S.C. §103(a).

In addition with respect to claims 27, 41 and 49, Huckle in view of O'Carroll and further in view of Ohler does not disclose the feature: "said service center receiving a vote on a usefulness of each received image in the at least one set of images".

The Examiner argues: "Huckle et al as modified by O'Carroll and Ohler et al fails to specifically teach: **(re claims 27, 41, and 49)** said service centre receiving a vote on a usefulness of **each** received image in the at least one set of images... LeFebvre et al teaches, at column 5, lines 13-29, obtaining user feedback on each direction the user receives in order to improve the navigation system."

In response, Applicant respectfully contend that LeFebvre, col. 5, lines 13-29 does not disclose the preceding feature of claims 27, 41 and 49 to constitute an obvious suggestion for modifying Huckle.

LeFebvre, col. 5, lines 13-29 discloses receiving a vote on usefulness of different values of a variable, the variable being the timing of an instruction to direct a driver to turn a moving vehicle by a specified angle. The purpose of the voting is to select one timing value that is determined from the voting to be adequate for the specified angle (LeFebvre, col. 5, lines 20-23). The process of LeFebvre, col. 5, lines 13-29 is performed for several different specified angles.

In contrast, the preceding feature of claims 27, 41 and 49 requires voting on a usefulness of each received image, and LeFebvre, col. 5, lines 13-29 does not disclose anything relating to images and their usefulness. The disclosure of a vote on the adequacy of the timing of an instruction to turn a moving vehicle by as specified angle is unrelated to a vote on the usefulness of a received image.

Therefore, claims 27, 41 and 49 are not unpatentable over Huckle as modified by O'Carroll, and further in view of Ohler and LeFebvre.

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

Date: December 7, 2009

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